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In re Application of :  
Jin, Hong et al :  
Serial No.: 09/724,388 : PETITION DECISION  
Filed: November 28, 2000 :  
Attorney Docket No.: 7682-051-999 :

This is in response to the petition under 37 CFR § 1.181, and M.P.E.P. § § 1003 ¶6 and 2307.02, filed April 10, 2006, requesting withdrawal of the Finality of the last Office action.

## BACKGROUND

A review of the file history shows that following a restriction requirement, mailed November 19, 2002, and incomplete election, made on May 19, 2003, the examiner mailed to applicants a letter concerning the bonafide non-response on June 17, 2003 as applicants had not elected the subgenus. The applicants responded with a complete election on September 09, 2003 electing Group I and Invention B drawn to the recombinant paramyxoviruses specifically virus RSV. The examiner mailed the first Office action on September 24, 2003, acting on claims 7, 8, 10-12, while claims 9, 13-16 were held to be non-elected. The Office set forth the following rejections in the First Office Action on the Merits :

Claim 12 was rejected under 35 U.S.C. 112, first paragraph, as lacking enablement in the specification, and as containing subject matter not described in the specification as to how to make or use the invention.

Claims 7, 10 and 11 were rejected under 35 U.S.C. 102(b), over Gharpure et al.

Claims 7, 8 and 11 were rejected under 35 USC 102(b) over Park et al.

Claims 7, 10 and 11 were rejected under 35 USC 102(a) over Crowe et al.

Claims 7, 8, 10 and 11 were rejected under 35 USC 102(b) over Collins et al and

Claim 11 was rejected under 35 USC 102(a) over Conzelmann et al, J Virol 68(2):713-19, or Schnell et al.

On March 24, 2004, applicants responded with affidavits under 37 CFR 1.131 and 1.132 and 19 pages of arguments and an amendment amending claim 7 and 11 and adding new claims 17-21. The rejections of record were addressed.

On June 15, 2004, the examiner responded with a Second Non-Final Office Action to the arguments, declaration and affidavits presented by the applicants :

Maintaining the 35 U.S.C. 112 rejection on claim 12.

Making another new rejection on claims 7, 8, 10-12, 17, 18, 20 and 21 under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirements.

Making another new rejection of claims 7, 8, 10-12, 17, 18 and 20 under 35 U.S.C. 112, first paragraph as failing to comply with the written description requirement.

Making another new rejection of claim 21 under 35 U.S.C. 112, first paragraph as failing to comply with the written description requirements.

The rejection of claims 7, 10 and 11 under 35 U.S.C. 102(b) over Gharpure et al was withdrawn.

The rejection of claims 7, 8 and 11 under 35 U.S.C. 102(b) over Park et al was also withdrawn.

The rejection of claims 7, 10 and 11 under 35 U.S.C. 102 (a) over Crowe et al was also withdrawn.

The rejection of claims 7, 8, 10 and 11 under 35 U.S.C. 102(b) over Collins et al was also withdrawn.

The rejection of claim 11 under 35 USC 102(a) over Conzelmann et al , J Virol. 68(2):713-19, or Schnell et al was maintained.

Applicants responded with a 18 pages of arguments on October 15, 2004 along with an amendment canceling claims 11 and 19, amending claims 12, 18 and 21 and adding a new claim 22.

The examiner mailed a Third Non-Final Office Action to applicants on December 28, 2004, as follows:

Maintained the rejection of claim 12 under 35 U.S.C. 112, first paragraph, for lack of enablement.

Maintained the rejection of claims 7, 8, 10-12, 17, 18, 20 and 21 under 35 U.S.C. 112 first paragraph lack of enablement requirement.

Maintained the rejection of claims 7, 8, 10-12, 17,18 and 20 under 35 U.S.C. 112 first paragraph lack of written description.

The rejection of claim 21 under 35 U.S.C. 112, first paragraph was withdrawn.

The rejection of claim 11 under 35 USC 102(a) over either Conzelmann et al, J Viro. 68(2); 713-19, or Schnell et al were also withdrawn.

A new rejection of claims 18 and 20-22 was made under 35 U.S.C. 102(e) over Murphy et al, US 5,993,824.

On June 15, 2005, the attorney had an interview with the examiner, supervisor and TC Director, in which claims 7 and 11 were discussed. A new response was sent in on October 04, 2005, with a new affidavit under 37 CFR 1.131 and 1.132 declaration and a 8 page response and arguments.

On June 28, 2005 applicants responded to the Third Non-Final rejection, with a 14 page response and arguments, and a 4 page IDS filed with a fee and not a statement under 1.97(e).

On January 04, 2006, the Examiner mailed an 18 page Final Office Action to applicants as follows:

Maintained the rejection of claims 12 and 20 under 35 U.S.C. 112, first paragraph enablement, Maintained the rejection of claims 7, 8, 10-12, 17, 18, 20 and 21 under 35 U.S.C. 112 first paragraph for lack of enablement requirement.

Maintained the rejection of claims 7, 8, 10-12, 17, 18 and 20 under 35 U.S.C. 112 first paragraph for lack of written description.

The rejection of claim 21 under 35 U.S.C. 112, first paragraph, was withdrawn.

Maintained the rejection of claims 18 and 20-22 under 35 USC 102(e) over Murphy et al US 5,993,824.

Made a new rejection of claim 7 under 35 U.S.C. 102(b) over Calain et al (J.Virol 67:4822-30 cited in the IDS filed June, 2005). The new grounds of rejection was made Final under the provisions of 37 C.F.R. § 1.97 ( c )(2), because the IDS was filed with a fee and without a statement under 1.97(e).

Applicants responded to the Final Office Action on April 10, 2006, with an amendment after Final and also this petition under 37 C.F.R. § 1.181, requesting withdrawal of the Finality of the last Office Action.

## **DISCUSSION**

The petition filed on April 06, 2006 has been considered carefully. The petition asserts that :

1. The claims are allowable,
2. The claims are identical to those of the US 6,033,886 patent,
3. An interference should be declared,
4. The Final Office Action required TC Director's approval and
5. Withdrawn claim 13 should be rejoined.

Each of these arguments will be addressed in turn.

M.P.E.P. § 2304.04 (b) sections B and C specifies that interference should be declared only if there are no prior art rejections and also only if the claims provide adequate support under 35 U.S.C. 112. See below:

(B) The required claim must not encompass prior art or otherwise be barred.

(C) The application must provide adequate support under 35 U.S.C. 112, first paragraph for the subject matter of the required claim.

From the Office actions, it is clear that the claims still stand rejected under 35 U.S.C. 102 (b) over Calain et al and under 35 U.S.C. 102(e) over Murphy et al. and hence do not meet the criteria of section (B).

The claims also remain rejected under multiple rejections under 35 U.S.C. 112 and hence do not provide adequate support for enablement and written description and thus do not meet the criteria under section (C).

Applicants' assertion that the claims are identical to those of the US 6,033,886 is incorrect. For example claim 1 of the US patent 6,033,886, is given by

1. A genetically manipulated, infectious, replicating, non-segmented negative-stranded RNA virus mutant, comprising at least one alteration selected from an insertion and a deletion, wherein the alteration is in a region of the virus genome selected from an open reading frame, a pseudogene region and an intergenic region.

This reads on the alteration region of the virus genome selected from an open reading frame, a pseudogene region and an intergenic region, as described in the specifications in column 5 lines 11 to 32, whereas the applicants claim, as given below, reads on modification of the insertion or deletion of the genome with a 44 nucleotide leader sequence at the 3' or 5' termini regions, as given on page 3 of the application. Accordingly the regions of the insertion and deletion are different in the two claims.

7. (Previously presented) A genetically manipulated, replication competent, infectious virus of the paramyxoviridae family wherein the virus genome comprises a modification wherein the modification is selected from an insertion, or deletion.

It can be seen from the above that the claims are not identical.

Applicants next argue that an interference should be declared. 37 CFR § 41.02 states that an interference cannot be declared until examination is completed. 37 CFR § 41.02 provides a definition of completion of examination.

**§ 41.102 Completion of examination.**  
Before a contested case is initiated, except as the Board may otherwise authorize, for each involved application and patent:

- (a) Examination or reexamination must be completed, and
- (b) There must be at least one claim that:
  - (1) Is patentable but for a judgment in the contested case, and
  - (2) Would be involved in the contested case.

Because no claim has been indicated as patentable, consideration of a potential interference is premature. An interference has not been declared, because examination is not complete, the claims are not allowable under M.P.E.P. § 2304.04 (b) sections B and C and the claims are not identical.

Applicants argue that the Final Office Action required TC Director's approval. This is incorrect. TC Director's approval pursuant to M.P.E.P. § 1003 ¶6 is required when , see below,

6. Actions which hold unpatentable claims copied from a patent for interference purposes where the grounds relied upon are equally applicable to the patentee,

Because the claims are not identical, and the claims are not in a condition of allowance, no interference can be declared. In this instance TC Director's approval is not required.

Applicants argue that withdrawn claim 13 be rejoined and considered. This argument is not persuasive. In the paper filed November 2002 the examiner did a proper restriction between the product and the process. Applicants elected the product and are now asking for a rejoinder of one of the process claims. M.P.E.P. 821.04 and 821.04 (b) specifies that rejoinder of the process claims is only required when all the product claims are in a condition for allowance. This is not the case here.


In view of the above, the Office action mailed January 04, 2006 is Final and the reply filed April 10, 2005, has been considered a reply after Final, on which the examiner has already mailed an advisory action.

## **DECISION**

The petition under 37 CFR 1.181 is **DENIED** for the reasons set forth above.

**Applicants' remain under obligation to make a proper response to the Final Office action within the time period set therein or as may be extended under 37 CFR 1.136(a).**

Should there be any questions about this decision please contact Ms. Julie Burke, by letter addressed to Director, TC 1600, at the address listed above, or by telephone at 571-272-0512 or by facsimile sent to the general Office facsimile number 571-273-8300.



John LeGuyader  
Director, Technology Center 1600